



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1480
Alexandria, Virginia 22303-1480
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10 074,395 | 02 11 2002 | Craig Jon Hawker | 5075-0017.10 | 6233 |

7500 05 15 2003
Dianne E. Reed
REED & ASSOCIATES
800 Menlo Avenue, Suite 210
Menlo Park, CA 94025

EXAMINER

COLE, ELIZABETH M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1771

DATE MAILED: 05 15 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

10/074.395

HAWKER ET AL

Office Action Summary

Examiner

Art Unit

Elizabeth M Cole

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24-29 is/are rejected.
- 7) ☒ Claim(s) 30-39 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 6) ☐ Other

Art Unit: 1771

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaeth et al.

U.S. Patent No. 5,869,135. Vaeth et al discloses a material comprising a substrate, a plurality of self-assembled monolayers disposed on the substrate in a pattern and additional coatings which may be formed on the substrate. See col. 2, lines 10-64 and col. 5, lines 1-5. The substrate may comprise metal, metal oxide or silicon. See examples. Vaeth et al differs from the claimed invention that Vaeth does not disclose that the pattern is such that it comprises a first regions which corresponds to a desired surface and a second region which corresponds to the inverse of the desired surface pattern. However, since Vaeth discloses that a pattern may be formed on the substrate, it would have been obvious to one of ordinary skill in the art to have selected the particular pattern which would produce the desired properties in the resulting material.

2. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vaeth et al as applied to claims 24-28 above, and further in view of Kumar et al, U.S. Patent No. 5,512,131. Vaeth does not disclose employing a polymeric substrate. Kumar et al teaches at col. 14, lines 41-61 teaches that polymeric materials are equivalent to metal, metal oxide and silicon substrate for use as the substrate for forming SAM layers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed polymeric

Art Unit: 1771

substrates as the substrate in Vaeth. One of ordinary skill in the art would have been motivated to employ polymeric substrates by the teaching by Kumar et al that such substrates are equivalents which were known to be suitable for use as the substrate on which SAM layers are formed.

3. Claims 30-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. With regard to the IDS, the U.S. patent documents have been considered. The non-patent literature cited was not considered because the prior application file was at an unavailable location at the time of this office action. These documents will be considered when the file is available to the examiner.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (703) 308-0037. The examiner may be reached between 6:30 AM and 5:00 PM Monday through Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (703) 308-2414.

Inquiries of a general nature may be directed to the Group Receptionist whose telephone number is (703) 308-0661.

The fax number for official faxes is (703) 872-9310. The fax number for official after final faxes is (703) 872-9311. The fax number for unofficial faxes is (703) 305-5436.



Elizabeth M. Cole
Primary Examiner
Art Unit 1771

Serial Number: 10 074.395

Page 4

Art Unit: 1771

e.m.c

March 24, 2003